

REMARKS

Reconsideration of this application is respectfully requested.

Although the restriction requirement for Claims 1-10 and 11-16 as being distinct inventions is respectfully traversed, Invention I (Claims 1-10) is elected for examination.

Claim 1 features a square root calculator. Claim 11 features a means for calculating a velocity reference by calculating a square root for use in adjusting the velocity of the transducer head to achieve the velocity reference. This is a means plus function feature. "[T]he PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination." *In re Donaldson Co.*, 16 F.3d 1189, 1194-95, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (en banc). Under *Donaldson*, the PTO must examine claim 11 according to 35 USC 112, para. 6, which states that:

An element in a claim for a combination may be expressed as a means ... for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.


So in examining the structure, i.e. the square root calculator, of claim 1, the examiner will also be examining the means feature of claim 11. Since the examination will cover both claims, there is no undue burden if all the claims of the present application are examined without restriction. Hence, restriction requirement is not proper.

Respectfully submitted,

SEAGATE TECHNOLOGY LLC  
(Assignee of Entire Interest)

Date

7/2/04

  
David K. Lucente, Reg. No. 36,202  
SEAGATE TECHNOLOGY LLC  
Intellectual Property Dept. - COL2LGL  
389 Disc Drive  
Longmont, CO 80503  
(720) 684-2295 (telephone)  
(720) 684-2588 (facsimile)

BEST AVAILABLE COPY